

REMARKS

The applicant thanks the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this Amendment.

Status of the Claims

Claims 1, 2, 4, 7-12, 14, 15, 17 and 19-21 are pending in the application. Claims 3, 5, 6, 13, 16 and 18 are cancelled by this Amendment. Claim 1 has been amended to incorporate the subject matter of cancelled claims 3, 5 and 6. Claim 12 has been amended to incorporate the subject matter of cancelled claims 13, 16 and 18.

Rejections Based Upon Rho And The Applicant's Disclosure

Claims 1, 2, 7, 8 and 11 remain rejected under 35 U.S.C. §103(a) as being obvious over Rho (U.S. Patent 6,057,896) in view of the Applicant's disclosure. The Examiner adds the teachings of Shimada (U.S. Patent 6,424,399) to the aforesaid rejection to reject claims 3, 4, 9 and 13-15. The Examiner adds the teachings of Jeong (U.S. Patent 6,137,551) to Rho and the Applicant's disclosure to reject claims 5, 10, 16 and 17. The Examiner adds the teachings of Shimada '325 (JP-03-141325) to Rho and the Applicant's disclosure to reject claims 6 and 18. The Examiner rejects claims 12, 19 and

20 over Rho in view of the Applicant's disclosure. Applicant respectfully maintains traversal of all of the aforesaid rejections.

First, the claims have been amended such that the subject matter of claims 3, 5 and 6 have been incorporated into claim 1 and the subject matter of claims 13, 16 and 18 have been incorporated into claim 12. Therefore, if the Examiner insists upon maintaining her position that the claims of the invention are unpatentable, the instant rejections would be converted into a rejection over five references: Rho, the Applicant's disclosure, Shimada, Jeong and Shimada '325.

However, this complicated combination of the prior art and the Applicant's disclosure (which is not prior art) can only be obtained through the application of impermissible hindsight reconstruction.

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (CAFC 1999). *See also In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (CAFC 2000). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Dembiczak* at 50 USPQ2d 1617. "The

invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” *Dembiczak* at 50 USPQ2d 1617. “The patent examination process centers on prior art and the examination thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness . . . The factual inquiry must be thorough and searching. It must be based on objective evidence of record.” *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-44 (Fed. Cir. 2002).

In this case, the cited art references are conventional art in which the pixel is formed on the protective layer covering the drain electrode and connected with the drain electrode through a contact hole formed by patterning the protective layer. However, in the invention, the pixel electrode is formed over the drain electrode and patterned. Afterwards, the protective layer is covered and patterned to open many portions of the pixel electrode with some portions overlapping the drain electrode. That is, the pixel area portion of the pixel electrode is opened and some portions of the pixel electrode are covered by the protective layer.

The primary reference of Rho fails to disclose or suggest a technology where the pixel electrode can connect to the drain electrode without recourse to

a contact hole. Rho additionally teaches away from the invention. These failures of Rho were discussed in detail at pages 14-16 of the Amendment filed July 13, 2004.

The Examiner turns to Shimada for teachings pertaining to buffer metal layers of Mo, Ti or Ta. The Examiner turns to Jeong for teachings pertaining to a storage electrode of a transparent conductive material such as ITO. The Examiner turns to Shimada '325 for teachings pertaining to an auxiliary electrode.

However, none of Shimada, Jeong or Shimada '325 addresses the failure of Rho to teach or suggest a liquid crystal display having a pixel electrode that can contact the drain electrode directly, and not through a contact hole, as is set forth in claims 1 and 12.

Further, the Examiner impermissibly turns to the Applicant's own disclosure to allege prior art. However, the Applicant again emphasizes that the utilization of the Applicant's disclosure without an admission of prior art is improper when the Applicant's disclosure represents the Applicants' own work. Riverwood International Corporation v. R.A. Jones & Co., Inc, 324 F.3d 1346, 66 U.S.P.Q.2d 1331 (C.A.F.C. 2003).

There is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits

knowledge of his own work, It is common sense that an inventor, regardless of an admission has knowledge of his own work . . . One's own work may not be considered prior art in the absence of a statutory basis and a patentee should not be "punished" for being as inclusive as possible and referencing his own work . . . 324 F.3d at 1355.

At page 2 of the Advisory Action mailed February 9, 2005, the Examiner is not persuaded:

It is respectfully noted the Applicant's arguments are not found to be persuasive. The Examiner respectfully notes that Applicant's Figures 5 and 6D are clearly referred to as conventional art. The Examiner has carefully reviewed Applicant's Specification and finds no clear indication that said conventional art is Applicant's own work. In fact, Applicant's Specification states that "Generally, a liquid crystal display (LCD) controls the light transmittance of liquid crystal cells in response to a video signal to thereby display a picture." (Specification at page 1). This "generally" refers to all of the conventional art. "Generally" means that this is the work of others. At least with reference to Figure 6D, Applicant states "[s]uch a liquid crystal display . . ." (Specification at page 7) which means, suggest and implies that his is the work of others. MPEP 2129 states that "[i]n the absence of another credible explanation, examiners should treat such subject matter as the work of another." Thus, Applicant's figures are the work of others and are appropriately "prior art."

However, the conventional art discussed in the specification is not general art, but is based on the mass-produced product currently being produced by the production line of the Applicant, LG. Philips LCD Co. Attached, please find a Declaration under 37 C.F.R. §1.132, provided to verify the status of the conventional art discussed in the specification. A signed Declaration will follow.

Finally, in the Advisory Action of April 6, 2005, the Examiner again turns to MPEP 2129, which more fully states:

A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work."). Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another. (final emphasis added)

However, "another credible explanation" was presented in the Response of March 14, 2005, which explained that the conventional art discussed in the specification represents the mass-produced product currently being produced by the production line of the Applicant, LG. Philips LCD Co.

As a result, the Applicant's disclosure cannot be combined with the other references to allege *prima facie* obviousness. Even if the references could be combined, a *prima facie* case of obviousness has still not been made over independent claims 1 and 12 because *inter alia* the primary reference of Rho

teaches away from the invention and impermissible hindsight reconstruction.

Claims depending upon independent claims 1 and 12 are patentable for at least the above reasons.

These rejections are overcome and withdrawal thereof is respectfully requested.

Prior Art

The prior art cited but not utilized by the Examiner shows the status of the conventional art that the invention supercedes. Additional instructions are accordingly not necessary.

Foreign Priority

The Examiner has acknowledged foreign priority most recently in the Office Action of April 13, 2004.

Drawings

The Examiner is respectfully requested to indicate whether the drawing figures are acceptable in the next official action.

Conclusion

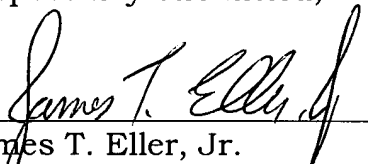
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 10, 2005



Respectfully submitted,

By 

James T. Eller, Jr.

Registration No.: 39,538

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorneys for Applicant